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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,551	03/09/2004	H. Thomas Graef	D-1217 R3	1996
28995	7590	11/02/2005	EXAMINER	
RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256			NICHOLSON III, LESLIE AUGUST	
			ART UNIT	PAPER NUMBER
			3651	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/796,551

Applicant(s)

GRAEF ET AL.

Examiner

Leslie A. Nicholson III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/2/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/23/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This is a first action on the merits of application 10/796551.

#### ***Election/Restrictions***

2. The restriction filed 8/11/2005 is hereby withdrawn. All original claims filed 3/9/2004 will be examined.

#### ***Specification***

3. The disclosure is objected to due to the following informalities:
  - as provided in 37 CFR 1.77(b), each of the section headings should appear in upper case, without underlining or bold type
  - reference numeral 245 has been used to designate both a "shaft" and a "spring portion" (P32/L2,3)
  - reference numeral 272 has been used to designate both a "bushing" (P37/L1) and a "tab portion" (P41/L9)Appropriate correction is required.

#### ***Drawings***

4. The drawings are objected to because of the following informalities:
  - failing to comply with 37 CFR 1.84(p)(4) because reference characters "154" and "164" have both been used to designate the same part in figure 9.

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- failing to comply with 37 CFR 1.84(p)(4) because reference characters "94" and "80" have both been used to designate the same part in figure 10.
- failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 216, 277

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

5. Claim 7 is objected to because there appears to be a typographical error in line 1 of the claim. It appears as though the intended word should be "interengaging" rather than "interingaging".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-17 are not distinct as to what the applicant is claiming by including the apparatus limitations (ie: "...wherein the tab portion is in rotatable supporting connection with a first end of a picking shaft...") within the method claim. It is recommended that the apparatus limitations be recited using a method step (ie: "...providing a tab portion and a picking shaft wherein the tab portion is in rotatable supporting connection with a first end of a picking shaft..."). See MPEP 2173.05(p).

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-27 are rejected under 35 U.S.C. 101 because the claims are directed to neither a method nor an apparatus (see ¶7) but rather embrace or overlap two statutory classes of invention. See MPEP 2173.05(p).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 1, as best understood by the examiner (see ¶7,9), is rejected under 35 U.S.C. 103(a) as being unpatentable over Graef USP 4,494,747 in view of Davidson USP 5,769,410.

Graef discloses a first end of a picking shaft (14) of a picking member (26) (fig.5), wherein rotation of the picking member is operative to separate end notes bounding a stack of notes one at a time from the stack in a housing in a cash dispensing automated banking machine.

Graef does not expressly disclose a method comprising:

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- a) deforming on a housing, a resilient tab portion (208), wherein the tab portion is in rotatable supporting connection with a first end of a picking shaft of a picking member (116)
- b) operatively engaging a second end of the picking shaft of the picking member opposed of the first end, with a rotatable drive shaft, wherein the resilient tab portion axially biases the picking member shaft to maintain engagement with the drive shaft

Davidson teaches a similar method comprising deforming on a housing, a resilient tab portion (208), wherein the tab portion is in rotatable supporting connection with a first end of a picking shaft of a picking member (116) (fig.3-6) operatively engaging a second end of the picking shaft of the picking member opposed of the first end, with a rotatable drive shaft, wherein the resilient tab portion axially biases the picking member shaft to maintain engagement with the drive shaft for the purpose of having the ability to remove the picking shaft for roller replacement (C5/L5-19).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the method steps of deforming on a housing, a resilient tab portion, wherein the tab portion is in rotatable supporting connection with a first end of a picking shaft of a picking member operatively engaging a second end of the picking shaft of the picking member opposed of the first end, with a rotatable drive shaft, wherein the resilient tab portion axially biases the picking member shaft to maintain engagement with the drive shaft, as taught by Davidson, in the method of Graef, for the purpose of having the ability to remove the picking shaft for roller replacement.

12. Claims 2-6, as best understood by the examiner (see ¶¶5,7,9), are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef USP 4,494,747 in view of Davidson USP 5,769,410 further in view of Svyatsky USP 4,607,833.

Graef discloses all the limitations of the claim (see ¶¶11) and further discloses a stripping member (44) biased toward a central disk portion (39) supported on the picking shaft (14), wherein the stripping member is generally operative to prevent all but an end note bounding a stack from being moved from the stack through engagement with the picking member (C8/L8-33). Graef not does not expressly disclose the use of a first leaf spring portion (58) integrally formed on the housing to bias a stripping member toward a central disk portion on the picking shaft.

Svyatsky teaches the use of a first leaf spring portion (58) integrally formed on the housing to bias a stripping member toward a central disk portion on the picking shaft (fig.3,4) for the purpose of providing a maintained force between the stripping member and central disk portion (C3/L23-29).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ a first leaf spring portion integrally formed on the housing to bias a stripping member toward a central disk portion on the picking shaft, as taught by Svyatsky, in the method of Graef, for the purpose of providing a maintained force between the stripping member and central disk portion.

Regarding claim 3, Graef discloses all the limitations of the claim (see ¶¶12) and further discloses a carry away roll (47), wherein the carry away roll is operative to move



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notes picked from the stack in engagement with the carry away roll between the central disk portion and the carry away roll (fig.19). Graef does not expressly disclose the use of a second leaf spring portion integrally formed on the housing to bias a carry away roll toward the central disk portion.

Svyatsky teaches the use of a second leaf spring portion (58) integrally formed on the housing to bias a carry away roll toward a central disk portion (fig.3,4) for the purpose of providing a maintained force between the carry away roll and central disk portion (C3/L23-29).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ a second leaf spring portion integrally formed on the housing to bias a carry away roll toward a central disk portion, as taught by Svyatsky, in the method of Graef, for the purpose of providing a maintained force between the carry away roll and central disk portion.

Regarding claim 4, Graef discloses all the limitations of the claim and further discloses the method wherein in (a) the picking member comprises the central disk portion and a first outboard disk portion supported on the picking shaft and disposed on a first transverse side of the central disk portion, and a second outboard disk portion supported on the picking shaft and disposed on a second transverse side of the central disk portion opposed of the first transverse side (fig.7).

Regarding claim 5, Graef discloses all the limitations of the claim and further discloses the method wherein in (a) the central disk portion of the picking member includes a high friction arcuate segment (42), the high friction arcuate segment including

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a leading area adapted to move a leading edge area of a note engaged therewith between the leading area and the stripping member, and a projecting portion (40) transversely disposed of the leading area, the projecting portion being operative to prevent deformation of the leading edge area (fig.7) (C10/L54-65).

Regarding claim 6, Graef discloses all the limitations of the claim and further discloses the method wherein the picking member in (a) includes the projecting portion, and wherein the projecting portion ceases to extend radially outward beyond the high friction arcuate segment in a termination area, and wherein the first outboard disk portion and second outboard disk portion each include a high friction arcuate segment (42a) generally aligned transversely with the termination area (fig.7) (C10/L10-15).

Regarding claim 7, Graef discloses all the limitations of the claim, but does not expressly disclose the method wherein (b) includes an interengaging projection and recess each operatively associated with one of the picking shaft and drive shaft.

Davidson teaches an interengaging projection and recess (210) each operatively associated with one of the picking shaft and drive shaft (fig.2,3) for the purpose of engaging for driving and disengaging for quick and easy replacement of the picking member.

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the use of an interengaging projection and recess each operatively associated with one of the picking shaft and drive shaft, as taught by Davidson, in the method of Graef, for the purpose of engaging for driving and disengaging for quick and easy replacement of the picking member.

Regarding claim 8, Graef discloses all the limitations of the claim and further discloses the method wherein the stripping member is supported on a stripping member support shaft, but does not expressly disclose the method wherein (c) includes operatively engaging the first leaf spring portion on the stripping member support shaft.

Svyatsky teaches a method wherein the first leaf spring portion operatively engages the stripping member support shaft (fig.3,4) for the purpose of biasing the stripping member against the picking member.

At the time of invention it would have been obvious to one having ordinary skill in the art to have the first leaf spring portion operatively engage the stripping member support shaft, as taught by Svyatsky, in the method of Graef, for the purpose of biasing the stripping member against the picking member.

Regarding claim 9, Graef discloses all the limitations of the claim and further discloses the method wherein (c) includes extending the stripping member support shaft in a first slot in supporting connection with the housing (fig.12).

Regarding claim 10, Graef discloses all the limitations of the claim and further discloses the method wherein the carry away roll is in supporting connection with a carry away roll shaft (46), but does not expressly disclose the second leaf spring portion operatively engaging the carry away roll shaft.

Svyatsky teaches the second leaf spring portion operatively engaging the carry away roll shaft (fig.2,3) for the purpose of biasing the carry away roll against the picking member.

At the time of invention it would have been obvious to one having ordinary skill in the art to have the second leaf spring portion operative engage the carry away roll shaft, as taught by Svyatsky, in the method of Graef, for the purpose of biasing the carry away roll against the picking member.

Regarding claim 11, Graef discloses all the limitations of the claim and further discloses the method wherein (d) includes extending the carry away roll shaft in a second slot in supporting connection with the housing (fig.14).

Regarding claim 12, Graef discloses all the limitations of the claim and further discloses the method wherein (c) the stripping member is positioned so as to be adjacent but transversely disposed from the projecting portion when the picking member moves so the leading area and stripping member are in adjacent opposed relation so as to move a leading edge area of a note between the leading area and the stripping member (C10/L54-65) (fig.7,13,14).

Regarding claim 13, Graef discloses all the limitations of the claim and further discloses the method wherein in (d) the carry away roll is transversely disposed of both the stripping member and the projecting portion (fig.12,14).

Regarding claim 14, Graef discloses all the limitations of the claim and further discloses the method further comprising engaging the picking member with an end note bounding a stack of notes in the machine, rotating the picking member, wherein the end note is separated from the stack by relative movement between the central disk portion and the stripping member (fig.5) (C10/L60-65, C11/L8-18).

Regarding claim 15, Graef discloses all the limitations of the claim and further discloses the method further comprising rotating the carry away roll responsive to rotation of the central disk portion, wherein the end note is moved between the carry away roll and the central disk portion (C8/L33-42).

Regarding claim 16, Graef discloses all the limitations of the claim and further discloses the method subsequent to step (d) further comprising receiving at least one input from the user through at least one input device (5,6) of the automated banking machine, and rotating the picking member responsive to the at least one input (C6/L31-56).

Regarding claim 17, Graef discloses all the limitations of the claim and further discloses the method further comprising delivering the end note from the machine to the user (C1/L32-48).

**Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

L.N.  
10/28/2005

  
GENE O. CRAWFORD  
SUPERVISORY PATENT EXAMINER